

REMARKS

Claims 56, 69-71, 107, and 110-112 are pending in this application for the Examiner's review and consideration. Applicants appreciate the courtesy extended to Applicant's attorney, Paul E. Dietze, in an interview on March 5, 2004. The comments appearing herein are substantially in accordance with those presented and discussed in the interview.

The specification was amended, as suggested by the Examiner in the interview, to correct the structure of Formula IV at page 5, lines 24-30. Specifically, the structure of Formula IV was amended to include an oxygen atom between the phosphorous atom and the Z group (*See, e.g.*, Specification, page 11, lines 1-7). The specification was also amended to correct a typographical error in the names of the compounds synthesized in Examples 5 and 6. Specifically, Example 5 was amended to recite --decyloxypropyl-- rather than "decoxypropyl" and Example 6 was amended to recite --dodecyloxy-- rather than "dodecoxy."

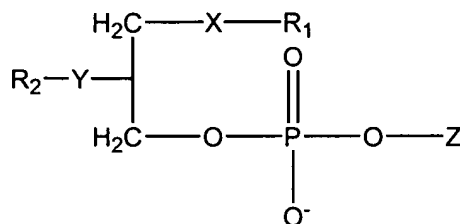
Claim 107 was amended, to be consistent with Example 6 of the specification, *i.e.*, to recite --dodecyloxy-- rather than "dodecoxy." No new matter has been added by these amendments so that their entry at this time is warranted.

THE REJECTION UNDER 35 U.S.C. § 101 AND 35 U.S.C. § 112. FIRST PARAGRAPH

Claims 56, 69-71, 107, and 110-112 were rejected under 35 U.S.C. § 101 and 35 U.S.C. § 112, first paragraph, for the reasons set forth on pages 2-4 of the Office Action. The Examiner rejected the claims under 35 U.S.C. § 101 alleging that the claims are not supported by either a specific asserted utility or a well established utility. The Examiner then further rejected the claims under 35 U.S.C. § 112, first paragraph, alleging that one skilled in the art would not know how to use the claimed invention since the invention is not supported by a specific asserted utility or a well established utility. Applicants respectfully traverse.

Applicants respectfully submit that claims 56, 69-71, 107, and 110-112 are supported by a specific asserted utility. Specifically, they are useful for treating viral infections (*See, e.g.*, Specification, page 11, lines 1-7). The above-mentioned claims are all directed to a method of treating viral infections using 3'-azido-3'-deoxy-5'-(dodecanamido-

2-decyloxypropyl)-phosphothymidine, *i.e.*, the compound of Example 5 (claims 56 and 69-71), or 3'-azido-3'-deoxy-5'-(dodecyloxy-2-decyloxypropyl)-phosphothymidine, *i.e.*, the compound of Example 6 (claims 107 and 110-112). Each of these compounds is a compound that falls within the class of compounds defined by Formula III.



III

wherein X, Y, Z, R₁, and R₂ are defined in the specification.

The Examiner, acknowledges that the specification satisfies the “how to make” prong of the utility requirement but alleges that the specification “does not satisfy the ‘how to use prong’ of utility for the compounds” (*See, e.g.*, Office Action, page 4). Applicants note, however, that the specification clearly states at page 11, lines 1-7 that compounds of Formula III, having an oxygen between the phosphorous atom and the Z group, have utility at “combating viral infection.” Indeed, during the interview the Examiner acknowledged that the disclosure at page 11, lines 1-7 satisfies the “how to use prong” of the utility requirement for compounds of Formula III.

The Examiner also stated that when she entered the names provided in Examples 5 and 6 into ChemDraw, the resulting structure obtained by ChemDraw was not consistent with the structure of Formula III. The mere fact that the Examiner’s ChemDraw program did not recognize the names used in Examples 5 and 6, however, does not mean that these names are inconsistent with the structure of Formula III or incorrect names for the compounds synthesized in these Examples. As discussed during the interview, there are many ways to name a compound. For example, even a simple compound like acetone has numerous names including, in addition to acetone, dimethylketone and 2-propanone. That the Examiner’s ChemDraw program did not recognize the names used in Examples 5 and 6 simply means that ChemDraw uses a different system for naming compounds than the system that was used by the inventors. The nomenclature system used by the inventors, however, is not incorrect. Indeed, as noted at the interview, the system used by the

inventors to name the compounds synthesized in Example 5 and 6 of the specification is the same as the system used in a peer reviewed journal to name analogous compounds (*See, e.g., Antiviral Chemistry and Chemotherapy*, 9:157-165 (1998), which was submitted to the Examiner as part of the Declaration of Dr. L Kucera submitted with the amendment filed January 29, 2003). Accordingly, the nomenclature for the compounds synthesized in Example 5 and 6 are consistent with the structure presented in Formula III having an oxygen between the phosphorous atom and the Z group. For the above reasons, Applicants respectfully request that the rejection of claims 56, 69-71, 107, and 110-112 under 35 U.S.C. § 101 and 35 U.S.C. § 112, first paragraph, be reconsidered and withdrawn.

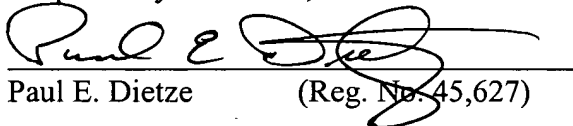
CONCLUSION

It is respectfully submitted that all claims are now in condition for allowance, early notice of which would be appreciated. Should the Examiner disagree, Applicants respectfully request a telephonic or in-person interview with the undersigned attorney to discuss any remaining issues and to expedite the eventual allowance of the claims.

No fees are believed to be required for this submission. Should any fees be required, however, please charge those fees to Morgan, Lewis & Bockius LLP deposit account no. 50-0310.

Date March 22, 2004

Respectfully submitted,


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